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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,361	07/10/2000	Jay S. Walker	96-139XX	9450
22927	7590	10/18/2005	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/613,361	Applicant(s) WALKER ET AL.	
	Examiner Ella Colbert	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-79 and 81-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-79 and 81-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 70-79 and 81-91 are pending. Claim 91 has been added in this communication filed 07/28/05 entered as Response After Non-Final action and Request for Extension of Time.
2. The claim objections to claims 70, 73, 81, and 83 are hereby withdrawn due to a recent "Precedential Decision".

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 70-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,909,673) Gregory in view of (US 5,377,271) Foreman et al, hereafter Foreman.

With respect to claims 70, 73, 76, 77, 78, and 79, Gregory teaches, A method for issuing a gift certificate corresponding to a financial account, comprising the steps of: generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier (col. 5, lines 64-67 and col. 6, lines 1-17); producing a gift certificate including thereon said certificate identifier (col. 6, lines 31-39); and distributing said gift certificate to an owner of said financial account (col. 5, lines 56-63).

Gregory failed to teach, said gift certificate not including said account identifier.

Foreman teaches, said gift certificate not including said account identifier (col. 7, lines 3-19, fig. 9, and fig. 10 –shows security code numbers for the money order). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have gift certificate not include an account identifier and to modify in Gregory because such a modification would allow Gregory to have an internal controller and operator security that can be programmed for varying security levels.

With respect to claims 73, 77, and 79 Gregory further teaches, a computer means (fig. 1 (12)) and distributing said gift certificate to a recipient (col. 10, lines 21-32).

With respect to claims 76 and 78, Gregory teaches, means for distributing said gift certificate to an owner of said financial account (col. 5, lines 56-63).

With respect to claims 71 and 74, Gregory teaches, The method of claim 70 wherein the financial account identifier cannot be discerned from the gift certificate identifier by a third party (col. 6, lines 18-22 and lines 31-39 and col. 8, lines 45-53).

With respect to claims 72 and 75, Gregory teaches, The method of claim 70, further including the steps of: receiving an indication of a gift certificate redemption (col. 9, lines 50-59); and updating stored account data to reflect the redemption (col. 10, lines 46-55).

With respect to claim 81, A method comprising: Gregory teaches, producing a gift certificate (col. 21, line 58-col. 22, line 50 and fig. 5B); and

in which the account identifier identifies a credit card account; and distributing the gift certificate to an owner of the credit card account (col. 17, lines 33-65).

Gregory failed to teach, the gift certificate including a sixteen-digit identifier, in which the sixteen-digit certificate is an alias of an account identifier that identifies a financial account. Foreman teaches, the gift certificate including a sixteen-digit identifier (col. 7, line 31- col. 8, line 58), in which the sixteen-digit certificate is an alias of an account identifier that identifies a financial account (col. 8, lines 16-40).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the gift certificate including a sixteen-digit identifier, in which the sixteen-digit certificate is an alias of an account identifier that identifies a financial account and to modify in Gregory because such a modification would allow Gregory to have a special program generated security numerical indicia defined by a printed character on an unprinted background.

With respect to claims 82 and 84, Gregory teaches, in which the gift certificate is for a single use (col. 5, line 56-col. 6, line 16).

With respect to claims 83 and 91, Gregory teaches, A method comprising: determining stored account data associated with a financial account (col. 5, line 64-col. 6, line 8), in which the account data includes an account identifier that identifies the financial account (col. 6, lines 2-15). Gregory failed to teach, generating an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; producing a gift certificate, the gift certificate including the alias identifier; and providing the gift certificate to a recipient. Foreman teaches, generating an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier;

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producing a gift certificate, the gift certificate including the alias identifier; and providing the gift certificate to a recipient (col. 6, lines 26-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; producing a gift certificate, the gift certificate including the alias identifier; and providing the gift certificate to a recipient and to modify in Gregory because such a modification would allow Gregory to have a predetermined number sequence corresponding to the serial number of a particular money order form (gift certificate) which is considered an alias identifier.

With respect to claim 85, this dependent claim is rejected for the similar rationale as given above for claims 70, 73, and 76-79.

With respect to claim 86, this dependent claim is rejected for the similar rationale as given above for claim 81.

With respect to claim 87, Gregory teaches, The method of claim 83, in which the recipient is an owner of the financial account (col. 17, lines 10-65).

With respect to claim 88, Gregory and Foreman failed to teach, The method of claim 83, in which the financial account is a credit card account, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the financial account to be a credit card account because the gift certificate purchaser will have to use some form of payment for the purchase of the gift certificate. A credit card account is a design choice as a method of payment.

With respect to claim 89, Gregory teaches, The method of claim 83, in which the financial account is a checking account (col. 1, lines 49-59).

With respect to claim 90, Gregory teaches, The method of claim 83, in which the gift certificate comprises at least one of: a paper certificate (col. 17, lines 52-65 and fig. 6), a stored value card (col. 1, lines 49-59). Gregory and Foreman failed to teach, a magnetic stripe card but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a magnetic stripe card and to modify in Gregory because such a modification would allow Gregory to have a card that contains a dollar amount limit and when swiped deducts a dollar amount from the card.

Response to Arguments

5. Applicants' arguments filed 07/28/05 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: "The Examiner has not established substantial evidence of record that would support a *prima facie* case of obviousness of any claim. Specifically, there is no substantial evidence that (i) would support any finding that all of the features of any claim are suggested by the cited references, alone or in any combination; or (ii) would support any finding that a motivation existed at the time of invention to provide all of the features of any claim" has been considered but is not persuasive. Response: A conclusion of obviousness is established "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Also see MPEP 2144 entitled "Sources of Rationale

Supporting a Rejection Under 35 U.S.C. 103: RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART – RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT.”

Issue no. 2: Applicants’ argue: The References do not disclose all of the limitations of any of the Independent claims 70, 73, 76, 77, 78, and 79 and we dispute that Foreman discloses or suggests *a gift certificate not including said account identifier* and with respect to Gregory, we do not agree that Gregory teaches all of the other features of claims 70, 73, 76, 77, 78, and 79. The Examiner has failed to establish a prima facie case of obviousness has been considered but is not persuasive. Response: It is interpreted that the numbers on the “travelers Express International Money order” does not include an account identifier as stated in col. 7, lines 3-19, fig. 9, and fig. 10 – shows security code numbers for the money order).

Issue no. 3: Applicants’ argue: There is not motivation to combine the cited references has been considered but is not persuasive. Response: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Foreman is interpreted to teach, a gift certificate (money order or voucher) not including the account identifier.

Gregory teaches a money order with an identifying number of the money order which is not considered an account identifier. Foreman is mentioned on the face of the Gregory patent which indicates they are combinable references.

Issue no. 4: Applicants' argue: The references do not disclose all of the limitations of independent claims 81 and 83 and dependent claims that depend there from has been considered but is not persuasive. Response this argument has been addressed above in reference to the other independent claims 70, 73, 76, 77, 78, and 79. Therefore, there is not any reason to address this argument again. Furthermore, it is interpreted that Gregory teaches the gift certificate including a sixteen-digit certificate identifierin which the sixteen-digit certificate identifier is an alias of an account identifier that identifies a financial account in col. 7, line 31-col. 8, line 58.

Conclusion: The Examiner carefully drew up a correspondence of each of Applicants' claimed limitations, one or more referenced passages in Gregory and Foreman, what is well known in the art and what is obvious to one having ordinary skill in the art at the time the invention was made.

The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court determined that to read a claim in light of the specification, to thereby interpret

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limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. "The court found that applicant was advocating the latter, e.g., the impermissible importation of subject matter from the specification into the claim).<

Applicants' are respectfully requested to point out to the Examiner and to distinctly claim that which is considered to be the inventive concept in the claims and in the claim language.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

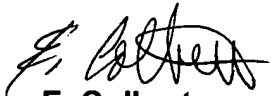
Inquiries

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
Primary Examiner
October 14, 2005